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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,788	10/01/2003	Hiroshi Yoshida	044499-0179	4152
22428	7590	09/21/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			VON BUHR, MARIA N	
		ART UNIT		PAPER NUMBER
				2125

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

JL-3

Office Action Summary	Application No.	Applicant(s)
	10/674,788	YOSHIDA ET AL.
	Examiner	Art Unit
	Maria N. Von Buhr	2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 Oct 2003, 11 Feb 2004 & 04 Jun 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 October 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10012003&06042004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Examiner acknowledges receipt of Applicant's preliminary amendment, received 01 October 2003; which amends the specification and claims 10 and 17. Claims 1-17 remain pending in this application.
2. Receipt is acknowledged of papers submitted under 35 U.S.C. §119(a)-(d), which papers have been placed of record in the file.
3. Examiner acknowledges receipt of Applicant's information disclosure statements, received 01 October 2003 and 04 June 2004, with accompanying reference copies, which have been taken into consideration for this Office action.
4. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which Applicant regards as his invention.

5. Claims 1-17 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In claim 1, there is no clear and proper antecedent basis for "the service contract information" (lines 7-8 of the claim) and "the contract" (line 8), nor is there any functional antecedence for any such service contract information having been "produced" (line 8) nor for any application program having been "stipulated in the contract information." There is further no clear and proper antecedent basis for "the device configuration" (line 11) and "the required device driver" (line 13), nor is there any functional antecedence for any "group of device drivers" having been "prepared" (line 14). Furthermore, there is no clear and proper antecedent basis for "the device driver" (last line of the claim), since a plurality have previously been provided for. Also, lines 7-9 are grammatically awkward, which makes the claim unclear with regard to what actually gets downloaded (i.e.; is the production of service contract information based upon the contract and the application program stipulated in the contract information, with only the service contract information being downloaded; or, is the production of service contract information based upon the contract, with the service contract information and the application program stipulated in the contract information being downloaded?). Additionally, the posed task of the preamble (i.e.; to characterize a "method of providing a board packaging line program") does not seem to be supported by the body of the claim, which is instead directed only to steps culminating in the downloading of device drivers, using an existing board

packaging line program. Hence, no actual “providing a board packaging line program” has been claimed, and the body of the claim seems to have no nexus with the preamble of the claim. These ambiguities present uncertainty with regard to the metes and bounds of the claim.

In claim 2, the claim language is grammatically awkward. Also, there is no clear and proper antecedent basis for “the set-up management,” “the time-lapse variation management” and “the defect cause estimation,” and no context for such elements is evident within the instant claim language. Further, the phrase “can be used” is not a positive recitation of function, so the claim is unclear with regard to what, if any, patentable weight such a “wherein” clause carries. Also, there are no clear metes and bounds to such a phrase.

In claim 3, “packing” should be corrected to -- packaging --, in order to maintain consistent terminology. Further, there is no clear and proper antecedent basis for “the applicable board packing line coordinating computer,” “the number of registerable devices” and “the number of modifiable devices,” nor is there any functional antecedence for a computer being “applicable” nor for any devices being “registerable” and “modifiable.” Also, there is no clear context for “the service contract information is produced with each board packaging line as a basic unit” (emphasis added), since only one packaging line has been accounted for within the instant claim language. Relatedly, since there is only one presented packaging line, there is no clear context for requiring “information for identifying the board packaging line.”

In claim 4, the claim language is grammatically awkward. Also, there is no clear and proper antecedent basis for “the client identification information,” nor is there any functional antecedence for “the input/output correspondence between the application program and the applicable devices.”

In claim 5, there is no functional antecedence for “the case where the device configuration of the board packaging line changes after introducing a predetermined application program to the board packaging line” nor for “the case where ... the scope of change in the device configuration is not more than the changeable number of devices contained in the original service contract information.” Also, there is no clear and proper antecedence for “the changeable number of devices,” “the original service contract information,” “the terms and conditions of the contract” nor “the changed applicable device,” while there is further no functional antecedence for any correspondence existing between the “device driver” and the “changed device configuration.”

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In claims 6-9, similar antecedent basis problems, and lack of functional antecedence, for various claim elements exist, as presented above. These ambiguities present uncertainty with regard to the metes and bounds of these claims.

Further in regard to claims 2-9, these dependent claims appear to merely be trying to set conditions or establish functionality. However, they fail to correlate such functionality to either any of the method steps or any hardware elements given in parent claim 1. Therefore, the metes and bounds of these dependent claims cannot be determined.

In claims 11 and 12, similar ambiguities exist as were presented above, with regard to claim 1.

In claims 13-17, Examiner cannot determine even the class of invention being claimed, since it is unclear whether these claims are method, system or apparatus type claims. No actual physical elements are claimed as being connected in a particular structure (system type), no actual devices with specified functionality (apparatus type) nor specific steps of a process (method type) have been claimed, and again the "wherein" clauses appear to merely be trying to set conditions or establish functionality. However, such "wherein" clauses fail to correlate such functionality to any method steps or any hardware elements, nor to anything in the preamble of these claims. Hence, no metes and bounds for these claims can be determined.

The remainder of the claims are rejected as necessarily incorporating the above-noted ambiguities of their parent claims.

6. Due to the above-noted ambiguities and confusion in claims 2-9 and 13-17, no art has been applied thereto, see *In re Steele*, 49 CCPA 1295, 305 F.2d 859, 134 USPQ 292 (1962) and *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Examiner will not speculate as to the intended meaning.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by Applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by Applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by Applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1 and 10-12 are rejected under 35 U.S.C. §102(a) and (e) as being clearly anticipated by McCannon et al. (U.S. Patent No. 6,607,314), which discloses an “apparatus for and method of updating a software routine,” wherein “a computer operator must obtain and load drivers required to interface each of the varied devices attached to a computer. In addition, to access increased functionality or compatibility, the operator must update previously installed drivers as new versions are issued and released. In support of this function, device manufacturers maintain customer service facilities including databases for users to download the latest versions of supported device drivers. For example, the assignee of the instant patent application maintains an Internet web site for users to download the most recent version of device drivers. The assignee further provides for notification to registered customers when drivers are updated” (see at least, the abstract; col. 1, line 11 - col. 2, line 45), and “printer 10 also includes an interface to a source of device drivers. According to one embodiment, input/output module 12 of printer 10 includes an interface to a local network server 40 having access to a locally stored database of most current version of device drivers required by operating system and application software routines resident on platforms served by server 40. Local network server 40 may also provide access to Internet 44 for providing remote access to manufacturer maintained device driver databases 46. In yet another configuration such as when PC 30 is not networked, printer 10 may have dedicated access to Internet 44 to obtain downloads of device drivers from remote device driver database 46” (see at least, col. 5, lines 28-40).

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. Applicant is advised to carefully review the cited art, as evidence of the state of the art, in preparation for responding to this Office action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria N. Von Buhr whose telephone number is 703-305-3837 (until 12 October 2004) or 571-272-3755 (thereafter). The examiner can normally be reached on M-F (9am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on 703-308-0538. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Maria N. Von Buhr
Primary Patent Examiner
Art Unit 2125